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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,165	01/16/2001	Veronique Douin	05725.0827-00000	9808
22852	7590	02/24/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/759,165

Applicant(s)

DOUIN ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 4-17, 19-24, 26, 27, 29-34, 40-42 and 59-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 18, 25, 28, 38, 39 and 43-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2003 has been entered.

Applicants' election in the parent application is presumed to carry over to the instant RCE since applicants have not indicated a contrary intention.

### ***Claim Rejections - 35 USC 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 18, 25, 28, 38, 39, and 43-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Sweger et al. (US patent 5,482,704, or record), in view of Matsumoto et al. (U.S. Patent 6,010,689) and Uchiyama et al. (US Patent 5,876,705).

3. Sweger teaches a hair compositions containing amino-multicarboxylate modified starch. See the claims. Example 1 illustrates a starch modified with z-chloroethylaminodipropionic acid (CEPA) (see col. 6, line 44 through col. 7, line 10). The starch derivatives provide thickening and emulsion stabilization and exhibit good appearance and feel

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to the skin (see col. 1, lines 32-37., col. 9, lines 60-63). The reference teaches that polyacrylic acid polymers such as Carbopol resins are the leading thickeners and emulsion stabilizers in the skin care and hair care markets. The reference further teaches that CEPA-modified starch gives stable viscosity over time and is superior to the Carbopol® standard (see col. 9, lines 1-6).

4. Sweger does not teach expressly the other ingredients in the hair composition, such as conditioning agent behenyltrimethylammonium, or anionic surfactant alkyl ether sulfate.

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use hair conditioning agents, and surfactants because those are well known essential ingredients normally used for hair compositions. For example, Matsumoto et al. teaches that behenyltrimethylammonium is a well-known hair conditioning agent, and alkyl ether sulfate are anionic surfactant known to be useful in hair composition. See, particularly, column 2, line 13 to column 3, line 36, column 5, lines 28-50, and column 7, lines 13-65. Uchiyama et al. teaches that a conditioning shampoo composition may comprise anionic surfactant, conditioning agent, such as behenyltrimethylammonium and thickener. See, particularly, the claims, and column 22, lines 34-55. Further, The optimization of a result effective parameter, e.g., optimal amounts of each known ingredients in a cosmetic composition, or a proper pH, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

5. Claims 1-3, 18, 25, 28, 38, 39, and 43-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janchipraponvej (US Pat. 4,954,335) in view of Sweger et al (US Pat. 5,482,704) and Martino et al (US Pat. 6,210,689) and in further view of Uchiyama et al. .

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6. Janchipraponvej teaches clear conditioning compositions and methods to impart improved properties to hair. The compositions provide excellent wet comb and dry comb properties to the hair, and the hair demonstrates improved physical and cosmetic properties (see col. 7, lines 21-48). The compositions of Janchipraponvej contain quaternary ammonium compounds (see col. 8, line 8-47). Behenyltrimethylammonium chloride is specifically taught (see col. 10, lines 1-29). Weight percentages of the quaternary ammonium compound are taught (see col. 10, lines 30-45). The reference teaches the use of thickening agents such as polyacrylic acid derivatives, and that the resulting compositions are relatively viscous compositions that are stable to phase separation for an indefinite period of time (see col. 16, lines 9-32). A preferred range of pH from 5.5 to 6.5 is taught (see col. 14, lines 5-18). Additional surfactants are included in the composition (see col. 14, line 19 through col. 15, line 18). The reference lacks modified starch and anionic surfactants.

7. Sweger teaches cosmetic compositions containing amino-multicarboxylate modified starch. Example 1 illustrates a starch modified with z-chloroethylaminodipropionic acid (CEPA) (see col. 6, line 44 through col. 7, line 10). The starch derivatives provide thickening and emulsion stabilization and exhibit good appearance and feel to the skin (see col. 1, lines 32-37., col. 9, lines 60-63). The reference teaches that polyacrylic acid polymers such as Carbopol resins are the leading thickeners and emulsion stabilizers in the skin care and hair care markets. The reference further teaches that CEPA-modified starch gives stable viscosity over time and is superior to the Carbopol® standard (see col. 9, lines 1-6).

8. Martino teaches the use of alkyl ether sulfate salts as well known surfactants in cosmetic formulations (see col. 5, lines 1-26). The reference teaches that certain alkyl ether sulfate salts

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are particularly useful in combination with keratin treating cosmetic compositions containing amphoteric starch derivatives as disclosed in the reference (see abstract and col. 5, lines 16-17). Uchiyama et al. teaches that a conditioning shampoo composition may comprise anionic surfactant, conditioning agent, such as behenyltrimethylammonium and thickener. See, particularly, the claims, and column 22, lines 34-55. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Janchipraponvej by the addition of amphoteric starches as taught by Sweger and anionic surfactants as taught by Martino in order to benefit from the improved results of the amphoteric starches with respect to viscosity and thickening as taught by Sweger.

***Response to the Arguments***

Applicants remarks, exhibits and the declaration by Mme Mahe have been fully considered, but are not persuasive for reasons discussed below.

9. The declaration under 37 CFR 1.132 filed December 1, 2003 is insufficient to overcome the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 (US Pat. 4,954,335) based upon Janchipraponvej et al and the other reference herein cited as set forth above because:

Applicant generated data, proffered to obviate prior art teachings, lacks the probative force accorded data generated by independent, disinterested parties. It is well settled patent law "that it is not a difficult matter to carry out a process in such a fashion that it will not be successful and, therefore, the failures of experimenters who have no interest in succeeding should not be accorded great weight" In re Michalek, 74 USPQ 108, at 109 citing Bullard Company et al v. Coe, 147 F.2d. 568, 64 USPQ 359.

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Further, one of ordinary skill in the art would have not expected that CEPA carbomer have identical properties, including solubility. Therefore, the detailed procedure for making CEPA solution would not be the same as those for carbomer. See the examples in Sweger et al.


Applicants' remarks that the combination of the references would "render the prior art invention being modified unsatisfactory for its intended purpose" are not persuasive. Particularly, as discussed above, the evidence are not convincing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Primary Examiner

  
**SHENGJUN WANG**  
**PRIMARY EXAMINER**  
Shengjun Wang

February 18, 2004